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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,749	01/22/2002	Christopher Meyer	3781-0102P	7350

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

SAUCIER, SANDRA E

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,749

Applicant(s)

Meyer

Examiner

Sandra Saucier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 12, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) 1-17, 19, 21, 23, 25, and 29-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 20, 22, 24, and 28 is/are rejected.
- 7) ☒ Claim(s) 26 and 27 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 22, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-31 are pending. Claims 18, 20, 22, 24, 26-28 are considered on the merits. Claims 1-17, 19, 21, 23, 25, 29-31 are withdrawn from consideration as being drawn to a non-elected invention.

Election/Restriction

Applicant's election with traverse of Group XII in Paper No. 5 is acknowledged. In addition, the examiner has rejoined Group X as urged by applicant.

The traversal is on the grounds that it would place an unreasonable burden on applicant to file multiple applications. This is not found persuasive because the burden on the applicant is not an element considered in the formulation of a proper restriction requirement.

Applicants further argue that Group IX-XIII should be examined together because they are closely related. However, the claims appear to be directed to distinct inventions because they have distinct steps. Thus, the "closeness" of their relationship is not an element required to be analyzed in the formulation of a proper restriction requirement.

Applicants further argue that the examination of Groups IX-XIII would not place an undue burden on the Examiner, especially because they have overlapping classifications. However, the several inventions listed in the restriction requirement paper #4, are independent and distinct from one another as they require independent searches, particularly with regard to the literature searches. The examiner's search is not limited to the class/subclass to which the various groups belong. Clearly, a reference which would anticipate one of the above groups would not necessarily anticipate or even make obvious any of the others. If applicant does not agree with this statement, a statement by applicant on the record that the inventions are obvious over one another and that the applicant will accept a reference which renders one group anticipated or obvious will be accepted as rendering the other groups also anticipated or obvious might be persuasive to the rejoining of the claims.

An undue burden would ensue from the examination of multiple methods which have distinct steps. Burden lies not only in the search of US Patents, but in the search for literature and foreign patents and examination of the claim

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language and specification for compliance with the statutes concerning new matter, distinctness and scope of enablement.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent, (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18 and 20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US 6,268,471 [A].

The claims are directed to a one step method of identifying a compound capable of inhibiting the growth of a pathogenic microbe comprising: identifying a compound that inhibits the conversion of α -glucose-1-phosphate + ATP \rightarrow ADP-glucose and pyrophosphate (a reaction catalyzed by ADP glucose pyrophosphorylase).

The references are relied upon as explained below.

US 6,268,471 identifies a compound, csrA, which is a 61 amino acid polypeptide which inhibits the expression of glgC (ADP glucose pyrophosphate) (col. 4, l. 47) in *E. coli* and thus inhibits the conversion of α -glucose-1-phosphate + ATP \rightarrow ADP-glucose and pyrophosphate and the activity of ADP glucose pyrophosphorylase. The reference anticipates because it has the same one step method of identifying a compound which inhibits the reaction as in the claimed method. That the intent of the prior art and the intent of the claimed method as described in the preamble may not be the same is of little patentable weight because the method steps are identical.

Claims 18, 20, 22, 24 and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dietzler *et al.* [U].

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The claims are directed to a method of identifying a compound capable of inhibiting the growth of a pathogenic microbe comprising: incubating a sample of bacteria in the presence and absence of a test compound, assessing the effect on conversion of α -glucose-1-phosphate + ATP \rightarrow ADP-glucose and pyrophosphate wherein a lowered level of conversion in the presence of the test compound indicates that the test compound interferes with the activity of ADP glucose pyrophosphorylase (E.C. 2.7.7.27).

Dietzler *et al.* disclose a method comprising: incubating a sample of bacteria in media in the presence or absence of a compound as shown in Table 1, as assessing the effect of the activity of ADP-glucose synthetase (E.C. 2.7.7.27) in *E. coli*.

Also, on page 293, 6-azauracil is said to have been shown to be an inhibitor of ADP-glucose synthetase *in vitro*.

Allowable Subject Matter

Claims 26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. **Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198.** The number of the Fax Center for the faxing of official papers is (703) 872-9306 or for after finals (703) 872-9307.



Sandra Saucier
Primary Examiner
Art Unit 1651
May 12, 2003